

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: <b>Dolph</b>	§	
	§	Group Art Unit: <b>2621</b>
Serial No.: <b>10/803,631</b>	§	
	§	Examiner: <b>Tekle, Daniel T.</b>
Filed: <b>March 18, 2004</b>	§	
	§	Confirmation No.: <b>5810</b>
For: <b>Targeted Marketing Overlays for</b>	§	
<b>Digital Video Recorders</b>	§	

37945

PATENT TRADEMARK OFFICE  
CUSTOMER NUMBER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPEAL BRIEF (37 C.F.R. 41.37)**

A fee of \$30.00 is believed to be required for filing this Appeal Brief. Please charge this fee to IBM Corporation Deposit Account No. 09-0457. No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0457. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0457.

**REAL PARTY IN INTEREST**

The real party in interest in this appeal is the following party: International Business Machines Corporation of Armonk, New York.

### **RELATED APPEALS AND INTERFERENCES**

This appeal has no related proceedings or interferences.

## **STATUS OF CLAIMS**

### **A. TOTAL NUMBER OF CLAIMS IN APPLICATION**

The claims in the application are: 1-26

### **B. STATUS OF ALL THE CLAIMS IN APPLICATION**

Claims canceled: 24-26

Claims withdrawn from consideration but not canceled: None

Claims pending: 1-23

Claims allowed: None

Claims rejected: 1-23

Claims objected to: None

### **C. CLAIMS ON APPEAL**

The claims on appeal are: 1-23

### **STATUS OF AMENDMENTS**

Appellant did not file an Amendment after the Final Rejection dated January 28, 2008. The claims stand as written in the Amendment filed November 9, 2007.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

The following provides a concise explanation of the subject matter defined in each of the separately argued claims involved in the Appeal as required by 37 C.F.R. § 41.371(i)(v). The features are identified by corresponding references to the specification and drawings where applicable. It should be noted that the citations to passages in the specification and drawings for each feature do not imply that the limitations from the specification and drawings should be read into the corresponding claim element. Rather, this summary is provided for the convenience of the Board.

### **A. CLAIM 1 - INDEPENDENT**

Embodiments of the invention according to claim 1 provide a method for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) (FIG. 1, element 95; FIG. 2; and Specification [0015]) comprising:

- receiving a television program containing an original marketing from a service provider (Specification [0023]); (*see* FIG. 4, element 204; and Specification [0034]);

- storing the television program in the memory; (FIG. 4, element 204; and Specification [0034]);

- sending a user ID (Specification [0025]) and a program ID (Specification [0021]) to the service provider (Specification [0023]) to cause a local marketing content (Specification [0016]), based upon the user ID and the program ID, to be sent to the DVR; (FIG. 4, element 206; and Specification [0034]);

- determining whether a local marketing content (Specification [0016]) has been received at the DVR; (FIG. 4, element 212; and Specification [0035]);

- responsive to the determination that the local marketing content has been received at the DVR, creating a modified marketing (Specification [0018]) by modifying the original marketing with the local marketing content; (FIG. 4, elements 216, 218, and 220; and Specification [0036]); and

- displaying the television program with the modified marketing upon a user request. (FIG. 4, element 222; and Specification [0036]).

**B. CLAIM 2 - DEPENDENT**

Embodiments of the invention according to claim 2 provide the method of claim 1 further comprising:

determining whether a message indicating that no local marketing content exists for the television program has been received; (FIG. 4, element 208; and Specification [0035]); and

responsive to the determination that the message indicating that no local marketing content exists for the television program has been received, displaying the television program with the original marketing upon the user request. (FIG. 4, element 210; and Specification [0035]).

**C. CLAIM 3 - DEPENDENT**

Embodiments of the invention according to claim 3 provide the method of claim 2 further comprising:

responsive to the determination that the local marketing content has been received, determining whether the local marketing content is add-on marketing (Specification [0013]); (FIG. 4, element 214; and Specification [0036]); and

responsive to the determination that the local marketing content is add-on marketing, creating the modified marketing by adding the add-on marketing into the television program without modifying the substance of original marketing. (FIG. 4, element 216; and Specification [0036]).

**D. CLAIM 4 - DEPENDENT**

Embodiments of the invention according to claim 4 provide the method of claim 3 further comprising:

responsive to the determination that a local marketing content (Specification [0016]) has been received, determining whether the local marketing content is replacement marketing (Specification [0022]); (FIG. 4, element 214; and Specification [0036]); and

responsive to the determination that the local marketing content is replacement marketing, creating the modified marketing by replacing the original marketing with the replacement marketing. (FIG. 4, element 218; and Specification [0036]).

**E. CLAIM 5- DEPENDENT**

Embodiments of the invention according to claim 5 provide the method of claim 4 further comprising:

responsive to the determination that a local marketing content (Specification [0016]) has been received, determining whether the local marketing content is overlay marketing (Specification [0020]); (FIG. 4, element 214; and Specification [0036]); and

responsive to the determination that the local marketing content is overlay marketing, creating the modified marketing by placing the overlay marketing over the original marketing. (FIG. 4, element 220; and Specification [0036]).

**F. CLAIM 6 - INDEPENDENT**

Embodiments of the invention according to claim 6 provide a method for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) (FIG. 1, element 95; FIG. 2; and Specification [0015]) comprising:

receiving a user ID (Specification [0025]) and a program ID (Specification [0021]); (FIG. 5, element 304; and Specification [0037]);

determining the location of a user based on the user ID; (FIG. 5, element 306; and Specification [0037]);

determining whether a local marketing content (Specification [0016]) exists for a television program based on the program ID; (FIG. 5, element 308; and Specification [0037]); and

responsive to the determination that the local marketing content does exist, sending the local marketing content to the DVR. (FIG. 5, element 310; and Specification [0037]).



#### **G. CLAIM 8 - DEPENDENT**

Embodiments of the invention according to claim 8 provide the method of claim 7 wherein the location of the user is determined by cross-referencing the user ID with information stored in a user profile. (Specification [0006] and [0037]).

#### **H. CLAIM 12 - INDEPENDENT**

Embodiments of the invention according to claim 12 provide an apparatus for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) (FIG. 1, element 95; FIG. 2; and Specification [0015]) comprising:

a storage medium (FIG. 2, element 100; and Specification [0027]);

wherein the storage medium comprises instructions for a processor to perform steps comprising:

receiving a television program containing an original marketing from a service provider (Specification [0023]); (*see* FIG. 4, element 204; and Specification [0034]);

storing the television program in the memory; (FIG. 4, element 204; and Specification [0034]);

sending a user ID (Specification [0025]) and a program ID (Specification [0021]) to the service provider (Specification [0023]) to cause a local marketing content (Specification [0016]), based upon the user ID and the program ID, to be sent to the DVR; (FIG. 4, element 206; and Specification [0034]);

determining whether a local marketing content (Specification [0016]) has been received; (FIG. 4, element 212; and Specification [0035]);

responsive to the determination that the local marketing content has been received at the DVR, creating a modified marketing (Specification [0018]) by modifying the original marketing with the local marketing content; (FIG. 4, elements 216, 218, and 220; and Specification [0036]); and

displaying the television program with the modified marketing upon a user request. (FIG. 4, element 222; and Specification [0036]).

#### **I. CLAIM 17 - INDEPENDENT**

Embodiments of the invention according to claim 17 provide an apparatus for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) (FIG. 1, element 95; FIG. 2; and Specification [0015]) comprising:

    a storage medium (FIG. 2, element 100; and Specification [0027]);

    wherein the storage medium comprises instructions for a processor to perform steps comprising:

        receiving a user ID (Specification [0025]) and a program ID (Specification [0021]) from a DVR; (FIG. 5, element 304; and Specification [0037]);

        determining the location of a user based on the user ID; (FIG. 5, element 306; and Specification [0037]);

        determining whether a local marketing content (Specification [0016]) exists for a television program based on the program ID; (FIG. 5, element 308; and Specification [0037]); and

        responsive to the determination that the local marketing content does exist, sending the local marketing content to the DVR. (FIG. 5, element 310; and Specification [0037]).

#### **J. CLAIM 23 - INDEPENDENT**

Embodiments of the invention according to claim 23 provide an apparatus for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) (FIG. 1, element 95; FIG. 2; and Specification [0015]) comprising:

    at the DVR, receiving a television program containing an original marketing from a service provider (Specification [0023]); (*see* FIG. 4, element 204; and Specification [0034]);

    at the DVR, storing the television program in the memory; (FIG. 4, element 204; and Specification [0034]);

    at the DVR, sending a user ID (Specification [0025]) and a program ID (Specification [0021]) to the service provider (Specification [0023]) to cause the a local marketing content (Specification [0016]), based upon the user ID and the program ID, to be sent to the DVR; (FIG. 4, element 206; and Specification [0034]);

at the service provider, receiving the user ID and the program ID; (FIG. 5, element 304; and Specification [0037]);

at the service provider, determining the location of a user based on the user ID; (FIG. 5, element 306; and Specification [0037]);

at the service provider, determining whether a local marketing content (Specification [0016]) exists for the television program based on the program ID; (FIG. 5, element 308; and Specification [0037]);

at the service provider, responsive to the determination that the local marketing content does exist, sending the local marketing content to the DVR; (FIG. 5, element 310; and Specification [0037]);

at the DVR, determining whether the local marketing content has been received; (FIG. 4, element 212; and Specification [0035]);

at the DVR, responsive to the determination that the local marketing content has been received, creating a modified marketing (Specification [0018]) by modifying the original marketing with the local marketing content; (FIG. 4, elements 216, 218, and 220; and Specification [0036]);

at a display connected to the DVR, displaying the television program with the modified marketing upon a user request; (FIG. 4, element 222; and Specification [0036]);

at the DVR, determining whether a message indicating that no local marketing content exists for the television program has been received; (FIG. 4, element 208; and Specification [0035]);

at the DVR, responsive to the determination that the message indicating that no local marketing content exists for the television program has been received, displaying the television program with the original marketing upon the user request; (FIG. 4, element 210; and Specification [0035]);

at the DVR, responsive to the determination that the local marketing content has been received, determining whether the local marketing content is add-on marketing (Specification [0013]); (FIG. 4, element 214; and Specification [0036]);

at the DVR, responsive to the determination that the local marketing content is add-on marketing, creating the modified marketing by adding the add-on marketing into the television

program without modifying the substance of original marketing; (FIG. 4, element 216; and Specification [0036]);

at the DVR, responsive to the determination that a local marketing content (Specification [0016]) has been received, determining whether the local marketing content is replacement marketing (Specification [0022]); (FIG. 4, element 214; and Specification [0036]);

at the DVR, responsive to the determination that the local marketing content is replacement marketing, creating the modified marketing by replacing the original marketing with the replacement marketing; (FIG. 4, element 218; and Specification [0036]);

at the DVR, responsive to the determination that a local marketing content (Specification [0016]) has been received, determining whether the local marketing content is overlay marketing (Specification [0020]); (FIG. 4, element 214; and Specification [0036]);

at the DVR, responsive to the determination that the local marketing content is overlay marketing, creating the modified marketing by placing the overlay marketing over the original marketing; (FIG. 4, element 220; and Specification [0036]);

at the service provider, responsive to a determination that the local marketing content does not exist (FIG. 5, element 308; Specification [0038]), sending a message to the DVR indicating that there is not any local marketing content (FIG. 5, element 312; and Specification [0038]); and

wherein, at the service provider, the location of the user is determined by cross-referencing the user ID with information stored in a user profile. (Specification [0006] and [0037]).

## **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The grounds of rejection to review on appeal are as follows:

**A. GROUND OF REJECTION 1**

Whether claims 1-11 failed to fall within one of the four statutory categories of invention.

**B. GROUND OF REJECTION 2**

Whether claims 1-23 failed to be anticipated under 35 U.S.C. § 102(e) over U.S. Patent Application Publication No. 2003-0194199 (hereinafter “Roth”). Final Office Action pp. 3–6

## ARGUMENT

### A. GROUND OF REJECTION (Claims 1-11)

Claims 1-11 were rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Office Action dated February 24, 2009, page 2. Specifically, the Examiner stated:

Claim(s) 1-11 is/are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. The method of modifying a marketing steps, which listed in the claims, are not tied to the device that performs the editing process.

Claim 1 recites:

A method for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) comprising:  
receiving a television program containing an original marketing from a service provider;  
storing the television program in the memory;  
sending a user ID and a program ID to the service provider to cause a local marketing content, based upon the user ID and the program ID, to be sent to the DVR;  
determining whether a local marketing content has been received at the DVR;  
responsive to the determination that the local marketing content has been received at the DVR, creating a modified marketing by modifying the original marketing with the local marketing content; and  
displaying the television program with the modified marketing upon a user request.

The Federal Circuit, in *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (en banc), held that "the machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under § 101." *Id.* at 956. The court explained the machine-or-transformation test as follows: The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to

a particular machine, or by showing that his claim transforms an article. Appellants submit that claim 1 meets at least the machine limitation of Bilski in that it is tied specifically to a memory of a Digital Video Recorder. Additionally, claim 1 transforms the original marketing to a modified marketing. Therefore, for at least the foregoing reasons, claims 1-11 are patentable subject matter.

## **B. GROUND OF REJECTION 1 (Claims 1-23)**

Claims 1-23 were rejected under 35 U.S.C. § 102(e) over U.S. Patent Application Publication No. 2001/0013123 (hereinafter “Freeman”). Office Action dated February 24, 2009, pp. 3–6.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Further, “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Because the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements “arranged as in the claim.” *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983).

### **1. Claim 1**

The complete claim 1 recites:

A method for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) comprising:

receiving a television program containing an original marketing from a service provider;

storing the television program in the memory;

sending a user ID and a program ID to the service provider to cause a local marketing content, based upon the user ID and the program ID, to be sent to the DVR;

determining whether a local marketing content has been received at the DVR;

responsive to the determination that the local marketing content has been received at the DVR, creating a modified marketing by modifying the original marketing with the local marketing content; and

displaying the television program with the modified marketing upon a user request.

The Examiner alleges the limitations of Claim 1 are disclosed in the cited art. Specifically, the Examiner stated:

Freeman et al discloses a method for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) comprising: receiving a television program containing an original marketing from a service provider (paragraph 0027); storing the television program in the memory (paragraph 0072); sending a user ID and a program ID to the service provider to cause a local marketing content (paragraph 0031), based upon the user ID and the program ID, to be sent to the DVR; (paragraph 0090); determining whether a local marketing content has been received at the DVR (paragraph 0064); responsive to the determination that the local marketing content has been received at the DVR (paragraph 0064), creating a modified marketing by modifying the original marketing with the local marketing content (paragraph 0090); and displaying the television program with the modified marketing upon a user request (paragraph 0090 and fig. 1 a element 110).

Office Action dated February 24, 2009 p. 3.

In regard to the element “receiving a television program containing an original marketing from a service provider,” the Examiner cites Freeman, paragraph [0027]. Paragraph [0027] states the following:

[0027] In a customized programming creation system, the purpose is to provide one or more users, on an individual basis, programming calculated to be of particular interest to each user. The transmission center 102 in FIG. 1a provides a user at a reception site tailored programming based upon user preference information. Programming available for customized delivery to a user is preferably stored in a library of storage servers 214 in the transmission center 102. Storage servers 214 (see also FIGS. 2a and 2b) may be computer servers 134 with large data storage capacity and very fast file seek time for storing MPEG programming files or other files formatted in similar industry standard video and audio compression schemes. Storage servers 214 may alternately or additionally consist of programming files stored on optical media such as digital video disk 132 racks or other compact disk formats. Less preferable, although still functional, is program storage on video tape, audio tape, and other tape storage mechanisms. Such programming needs to proceed through the MPEG or other encoding process before transmission.

An analysis of paragraph [0027] shows that Freeman does not explicitly disclose the limitation at least because there is no mention of “an original marketing,” a “service provider” or



a “television program.” Nor can Freeman inherently disclose these features. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

In regard to the element, “sending a user ID and a program ID to the service provider to cause a local marketing content, based upon the user ID and the program ID, to be sent to the DVR,” the Examiner cites Freeman, paragraphs [0031] and [0090]. Paragraph [0031] states the following:

[0031] User preference information is generally collected at the receiver 108, generally through user input via a user interface device 148. The user interface device 148 is preferably a radio frequency or infrared remote control device, but could be a keyboard, a touch screen, or even a voice activated control interface. User preference information may also be collected and analyzed based upon user programming selections, such as through an event programming guide, and other viewing habits of the user. The user preference information is preferably transmitted to the transmission center 102 via a backchannel communication link 106. The user preference information is preferably stored in a user information database 136 at the transmission center 102. The user preference information may additionally be stored in the receiver 108 at the user's reception site, or in a user information database 136 that is physically remote from the transmission center 102 or receiver 108, but connected to one or both via a communication link or network.

Paragraph [0090] states the following;

[0090] The user profile may contain a wide variety of information concerning user characteristics for use in determining content to push to a user. The content may include any type of information such as video, audio, graphics, text, and multimedia content. Examples of content to be selectively pushed to the user as

part of the customized programming creation system based upon the user profile information include, but are not limited to, the following: advertisements, player profiles for sporting events, music or other audio information, icons representing particular services, surveys, news stories, and program suggestions. For example, through an interactive survey, the customized programming creation system can dynamically modify and update a user's donut to further fine-tune the process of selecting particular content to push to the user based upon the user's donut. In advertising context, the answers to survey questions may be used to provide a second level of information within an advertisement pushed to a particular user. The customized programming creation system may use demographic data in a user's donut, for example, to determine which advertisement or survey to push to the user. The user's answers to questions in the survey may be used to push additional advertisements to the user or additional content related to the advertisement previously pushed.

An analysis of paragraphs [0031] and [0090] shows that they are silent as to the foregoing limitation. The referenced paragraphs disclose "user preference information" and "pushing" content to a user based upon user profile information where the content includes advertising (see [0090], lines 6-9). Thus the limitation is neither expressly nor inherently disclosed.

In regard to the element, "determining whether a local marketing content has been received at the DVR," the Examiner cites Freeman, paragraph [0064]. Paragraph [0064] states:

[0064] The switch occurs in the multiplexer 224 by switching to a packet in a different data stream, for example from 300a to 300c. Instead of selecting the data packet identified by the next PID in the present data stream 300a, the multiplexer 224 chooses the synchronous PID from a corresponding data stream 300c. In order to choose the desired signal to which to switch, the multiplexer 224 identifies the PID of each incoming data packet and sends the PID information to the processor 258. Preferably, each incoming video and audio packet from the storage server 214 has its own PID. The processor 258 in turn identifies the next appropriate packets to select for transmitting to the user based on, for example, user reference information from the user information database 236 stored in memory 254, or user responses to interrogatories in the customized programming segments input through the user interface 148 at the receiver 108 (as shown in FIG. 1a), and received at the backchannel decoder demodulator 270 via a backchannel communication link. The switch could also be dictated at the direction of a producer at the transmission center 102. The interrogatory answers, user requests, producer directions, and user preference information, are processed by the processor 258 according to routines within the system software stored in memory 254 to select the indicated data packet and return the associated PID to the multiplexer 224. Alternatively, the desired PID may be part of the data codes, which are packetized as part of the program data stream. Upon receipt of the

switching routine instructions, the multiplexer 224 begins to look for the designated MPEG packet by its PID. In alternative embodiments, depending upon the hardware used, the switch can be entirely controlled by the multiplexer 224, if for example it is constructed with a register to store PID information for switching.

An analysis of Freeman, paragraph [0064] shows that it is silent as to this limitation. Thus the limitation is neither expressly nor inherently disclosed.

In regard to the element, “responsive to the determination that the local marketing content has been received at the DVR, creating a modified marketing by modifying the original marketing with the local marketing content,” the Examiner cites Freeman, paragraph [0090]. Freeman, paragraph [0090] discloses and “pushing” content to a user based upon user profile information where the content includes advertising (see [0090], lines 6-9). Indeed, Freeman is silent as to “creating a modified marketing by modifying the original marketing with the local marketing content.” Thus the limitation is neither expressly nor inherently disclosed.

In regard to the element, “displaying the television program with the modified marketing upon a user request,” the Examiner cites Freeman, paragraph 0090 and Figure 1a, element 110. Element 110 of Figure 1a is a television set. A television set infers a display but there is no teaching of “the modified marketing.” Therefore, Freeman, paragraph [0090] and FIG. 1a, element 110 are silent as to displaying the television program with the “modified marketing.” Thus the limitation is neither expressly nor inherently disclosed.

Thus, the cited art fails to teach each and every element as set forth in the claim. Therefore, Appellant respectfully requests that the rejection be reversed.

## **2. Claim 2**

Claim 2 recites:

The method of claim 1 further comprising:

- determining whether a message indicating that no local marketing content exists for the television program has been received; and

- responsive to the determination that the message indicating that no local marketing content exists for the television program has been received, displaying the television program with the original marketing upon the user request.

The Examiner states that Freeman discloses claim 2 as follows:

Freeman et al discloses a method of claim 1 further comprising:  
determining whether a message indicating that no local marketing content exists for the television program has been received (paragraph 0033); and responsive to the determination that the message indicating that no local marketing content exists for the television program has been received, displaying the television program with the original marketing upon the user request (paragraph 0033 and fig. 1a element 110).

Freeman, paragraph [0033] discloses “customized programming” that is “tailored to each user,” and is silent as to the limitations of claim 2. Further, Freeman is silent as to the limitations of claim 2. Figure 1a, element 110 is merely a television set. Thus Freeman does not disclose making a determination that “no local marketing content exists for the television program received.”

Thus, the cited art fails to teach each and every element as set forth in the claim. Therefore, Appellant respectfully requests that the rejection be reversed.

### 3. *Claim 3*

Claim 3 recites:

The method of claim 2 further comprising:

responsive to the determination that the local marketing content has been received, determining whether the local marketing content is add-on marketing;  
and

responsive to the determination that the local marketing content is add-on marketing, creating the modified marketing by adding the add-on marketing into the television program without modifying the substance of original marketing.

In addition to the features inherited from its base and any intervening claims that are not taught by the cited art, as discussed above, claim 3 also recites “determining whether the local marketing content is add-on marketing.” The Examiner states that Freeman discloses this element:

Freeman et al discloses a method of claim 2 further comprising: responsive to the determination that the local marketing content has been received (paragraph 0064 and 0073), determining whether the local marketing content is add-on marketing (paragraph 0073); and responsive to the determination that the local marketing content is add-on marketing, creating the modified marketing by adding the add-on marketing into the television program without modifying the substance of original marketing (paragraph 0090).

The cited portions of Freeman are silent as to the claim limitations. Paragraphs [0064] and [0090] have been discussed above. Paragraph [0073] states the following:

[0073] Additional memory 552 in the form of RAM or a storage server may be used at the receiver 550 in order to store programming segments, either temporarily for incorporating into a customized program, or for a longer period if the program segment is likely to be repeatedly desired or used in customized programming for the particular user. A programming segment could also be transmitted earlier than the desired presentation time and stored in memory 558 to be used to further customize a later transmitted program segment that is transmitted to a group of users.

An analysis of the cited art demonstrates that Freeman is silent as to “determining whether the local marketing content is add-on marketing” and also as to “creating the modified marketing by adding the add-on marketing into the television program without modifying the substance of original marketing.” These limitations are neither expressly nor inherently disclosed.

Thus, the cited art fails to teach each and every element as set forth in the claim. Therefore, Appellant respectfully requests that the rejection be reversed.

#### **4. *Claim 4***

In addition to the features inherited from its base and any intervening claims that are not taught by the cited art, as discussed above, claim 4 also recites “determining whether the local marketing content is replacement marketing.” The Examiner states the following in regard to this element:

Freeman et al discloses a method of claim 3 further comprising: responsive to the determination that a local marketing content has been received, determining whether the local marketing content is replacement marketing (paragraph 0090); and responsive to the determination that the local marketing content is replacement marketing, creating the modified marketing by replacing the original marketing with the replacement marketing (paragraph 0090).

Contrary to the Examiner’s assertion, Freeman is silent as to “determining whether the local marketing content is replacement marketing.” Thus, the cited art fails to teach each and every element as set forth in the claim.

Therefore, Appellant respectfully requests that the rejection be reversed.

#### **5. Claim 5**

In addition to the features inherited from its base and any intervening claims that are not taught by the cited art, as discussed above, claim 5 also recites “determining whether the local marketing content is overlay marketing.” In regard to claim 5, the Examiner states:

Freeman et al discloses a method of claim 4 further comprising:  
responsive to the determination that a local marketing content has been received,  
determining whether the local marketing content is overlay marketing (paragraph 0073 and 90); and responsive to the determination that the local marketing content is overlay marketing, creating the modified marketing by placing the overlay marketing over the original marketing (paragraph 0073 and 0090).

Paragraphs [0073] and [090] have been set forth above. An analysis of those paragraphs demonstrates that Freeman is silent as to “determining whether the local marketing content is overlay marketing.”

Thus, the cited art fails to teach each and every element as set forth in the claim. Therefore, Appellant respectfully requests that the rejection be reversed.

#### **6. Claim 6**

Claim 6 recites:

A method for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) comprising:  
receiving a user ID and a program ID;  
determining the location of a user based on the user ID;  
determining whether a local marketing content exists for a television program based on the program ID; and  
responsive to the determination that the local marketing content does exist,  
sending the local marketing content to the DVR.

The Examiner alleges these limitations are disclosed by Freeman:

Freeman et al discloses a method for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) comprising: receiving a user ID and a program ID (paragraph 0049); determining the location of a user based on the user ID (paragraph 0049); determining whether a local marketing content exists for a television program based on the program ID (paragraph 0073 and 0083); and

responsive to the determination that the local marketing content does exist, sending the local marketing content to the DVR (paragraph 0073).

Freeman [0049] states the following:

[0049] A processor 258 preferably coordinates and controls the functions of the storage servers 214 and transmission components such as the multiplexer 224, modulator 220, and the transmitter 228. The processor 258 can direct the selection and transmission of particular programming segments based upon system software stored in memory 254, preferably ROM, or from data codes stored with programming segments in the storage servers 214. A user information database 236 that collects and stores user preference information for customizing the programming segments selections may be a part of the memory 254, or it may be a separate but integrated system as indicated in FIG. 1a. A backchannel decoder/demodulator 270 receives user preference information, including interactive user inputs, viewing habits, and general information about a user from a connected user's receiver 108. This connection may be via telephony, two-way cable, the Internet, digital subscriber line, or other indirect or direct communication link.

An analysis of Freeman [0049] shows that Freeman is silent as to (1) “a user ID and a program ID,” (2) “determining the location of a user based on the user ID,” (3) “determining whether a local marketing content exists for a television program based on the program ID,” and (4) “responsive to the determination that the local marketing content does exist, sending the local marketing content to the DVR.”

Thus, the cited art fails to teach each and every element as set forth in the claim. Therefore, Appellant respectfully requests that the rejection be reversed.

## **7. Claim 8**

In addition to the features inherited from its base and any intervening claims that are not taught by the cited art, as discussed above, claim 8 also recites “a user profile.” Specifically, the Examiner states:

Freeman et al discloses a method of claim 7 wherein the location of the user is determined by cross-referencing the user ID with information stored in a user profile (paragraph 0049).

Freeman paragraph [0049] simply does not say that. (see Freeman [0049] set forth above.) Freeman is silent as to this limitation. Thus, the cited art fails to teach each and every element as set forth in the claim.

Therefore, Appellant respectfully requests that the rejection be reversed.

**8.      *Claims 7 and 9-11***

Claims 7 and 9-11 each depend from and inherit all the limitations of claim 6. As discussed above, claim 6 contains features and limitations that are not taught by the cited art. Thus, claims 7 and 9-11 each contain features and limitations that are not taught by the cited art. Therefore, Appellant respectfully requests that the rejection be reversed.

**9.      *Claim 12 and Claims 13-22***

Claims 12-22 comprise features and limitations similar to claims 1-11 respectively. As discussed above, claims 1-11 comprise features and limitations that are not taught by the cited art. Thus, claims 12-22 comprise features and limitations that are not taught by the cited art. Therefore, Appellant respectfully requests that the rejection be reversed.

**10.     *Claim 23***

In addition to the features and limitations that are similar to the features limitations of claims 1-11 that are not taught by the cited art, as discussed above, claim 23 comprises additional subject matter. Appellant hereby argues the addition subject matter of claim 23.

Claim 23 recites “at the DVR, sending a user ID and a program ID to the service provider to cause the a local marketing content, based upon the user ID and the program ID, to be sent to the DVR.” Freeman is silent as to this limitation.

Claim 23 also recites “at the service provider, receiving the user ID and the program ID.” Freeman is silent as to this limitation.

Claim 23 also recites “at the service provider, responsive to a determination that the local marketing content does not exist, sending a message to the DVR indicating that there is not any local marketing content.” Freeman is silent as to this limitation.

Thus, the cited art fails to teach each and every element as set forth in the claim.



**B. CONCLUSION**

As shown above, the Examiner has failed to state valid rejections against any of the claims. Therefore, Appellant requests that the Board of Patent Appeals and Interferences reverse the rejections. Additionally, Appellant requests that the Board direct the Examiner to allow the claims.

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Respectfully submitted,

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## **CLAIMS APPENDIX**

The text of the claims involved in the appeal is as follows:

1. A method for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) comprising:

receiving a television program containing an original marketing from a service provider;

storing the television program in the memory;

sending a user ID and a program ID to the service provider to cause a local marketing content, based upon the user ID and the program ID, to be sent to the DVR;

determining whether a local marketing content has been received at the DVR;

responsive to the determination that the local marketing content has been received at the DVR, creating a modified marketing by modifying the original marketing with the local marketing content; and

displaying the television program with the modified marketing upon a user request.

2. The method of claim 1 further comprising:

determining whether a message indicating that no local marketing content exists for the television program has been received; and

responsive to the determination that the message indicating that no local marketing content exists for the television program has been received, displaying the television program with the original marketing upon the user request.

3. The method of claim 2 further comprising:

responsive to the determination that the local marketing content has been received, determining whether the local marketing content is add-on marketing; and

responsive to the determination that the local marketing content is add-on marketing, creating the modified marketing by adding the add-on marketing into the television program without modifying the substance of original marketing.

4. The method of claim 3 further comprising:

responsive to the determination that a local marketing content has been received, determining whether the local marketing content is replacement marketing; and

responsive to the determination that the local marketing content is replacement marketing, creating the modified marketing by replacing the original marketing with the replacement marketing.

5. The method of claim 4 further comprising:

responsive to the determination that a local marketing content has been received, determining whether the local marketing content is overlay marketing; and

responsive to the determination that the local marketing content is overlay marketing, creating the modified marketing by placing the overlay marketing over the original marketing.

6. A method for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) comprising:

receiving a user ID and a program ID;

determining the location of a user based on the user ID;

determining whether a local marketing content exists for a television program based on the program ID; and

responsive to the determination that the local marketing content does exist, sending the local marketing content to the DVR.

7. The method of claim 6 further comprising: responsive to the determination that the local marketing content does not exist, sending a message to the DVR indicating that there is not any local marketing content.

8. The method of claim 7 wherein the location of the user is determined by cross-referencing the user ID with information stored in a user profile.

9. The method of claim 8 wherein the local marketing content is add-on marketing.

10. The method of claim 8 wherein the local marketing content is replacement marketing.

11. The method of claim 8 wherein the local marketing content is overlay marketing.

12. An apparatus for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) comprising:

a storage medium;

wherein the storage medium comprises instructions for a processor to perform steps comprising:

receiving a television program containing an original marketing from a service provider;

storing the television program in the memory;

sending a user ID and a program ID to the service provider to cause a local marketing content, based upon the user ID and the program ID, to be sent to the DVR;

determining whether a local marketing content has been received;

responsive to the determination that the local marketing content has been received at the DVR, creating a modified marketing by modifying the original marketing with the local marketing content; and

displaying the television program with the modified marketing upon a user request.

13. The apparatus of claim 12 further comprising:

determining whether a message indicating that no local marketing content exists for the television program has been received; and

responsive to the determination that the message indicating that no local marketing content exists for the television program has been received, displaying the television program with the original marketing upon the user request.

14. The apparatus of claim 12 further comprising:

responsive to the determination that the local marketing content has been received,  
determining whether the local marketing content is add-on marketing; and

responsive to the determination that the local marketing content is add-on marketing,  
creating the modified marketing by adding the add-on marketing into the television program  
without modifying the substance of original marketing.

15. The apparatus of claim 12 further comprising:

responsive to the determination that a local marketing content has been received,  
determining whether the local marketing content is replacement marketing; and

responsive to the determination that the local marketing content is replacement  
marketing, creating the modified marketing by replacing the original marketing with the  
replacement marketing.

16. The apparatus of claim 12 further comprising:

responsive to the determination that a local marketing content has been received,  
determining whether the local marketing content is overlay marketing; and

responsive to the determination that the local marketing content is overlay marketing,  
creating the modified marketing by placing the overlay marketing over the original marketing.

17. An apparatus for modifying a marketing stored within a memory of a Digital Video  
Recorder (DVR) comprising:

a storage medium;

wherein the storage medium comprises instructions for a processor to perform steps comprising:

receiving a user ID and a program ID from a DVR;

determining the location of a user based on the user ID;

determining whether a local marketing content exists for a television program based on the program ID; and

responsive to the determination that the local marketing content does exist, sending the local marketing content to the DVR.

18. The apparatus of claim 17 further comprising: responsive to the determination that the local marketing content does not exist, sending a message to the DVR indicating that there is not any local marketing content.

19. The apparatus of claim 17 wherein the location of the user is determined by cross-referencing the user ID with information stored in a user profile.

20. The apparatus of claim 17 wherein the local marketing content is add-on marketing.

21. The apparatus of claim 17 wherein the local marketing content is replacement marketing.

22. The apparatus of claim 17 wherein the local marketing content is overlay marketing.

23. An apparatus for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) comprising:

at the DVR, receiving a television program containing an original marketing from a service provider;

at the DVR, storing the television program in the memory;

at the DVR, sending a user ID and a program ID to the service provider to cause the a local marketing content, based upon the user ID and the program ID, to be sent to the DVR;

at the service provider, receiving the user ID and the program ID;

at the service provider, determining the location of a user based on the user ID;

at the service provider, determining whether a local marketing content exists for the television program based on the program ID;

at the service provider, responsive to the determination that the local marketing content does exist, sending the local marketing content to the DVR;

at the DVR, determining whether the local marketing content has been received;

at the DVR, responsive to the determination that the local marketing content has been received, creating a modified marketing by modifying the original marketing with the local marketing content;

at a display connected to the DVR, displaying the television program with the modified marketing upon a user request;

at the DVR, determining whether a message indicating that no local marketing content exists for the television program has been received;



at the DVR, responsive to the determination that the message indicating that no local marketing content exists for the television program has been received, displaying the television program with the original marketing upon the user request;

at the DVR, responsive to the determination that the local marketing content has been received, determining whether the local marketing content is add-on marketing;

at the DVR, responsive to the determination that the local marketing content is add-on marketing, creating the modified marketing by adding the add-on marketing into the television program without modifying the substance of original marketing;

at the DVR, responsive to the determination that a local marketing content has been received, determining whether the local marketing content is replacement marketing;

at the DVR, responsive to the determination that the local marketing content is replacement marketing, creating the modified marketing by replacing the original marketing with the replacement marketing;

at the DVR, responsive to the determination that a local marketing content has been received, determining whether the local marketing content is overlay marketing;

at the DVR, responsive to the determination that the local marketing content is overlay marketing, creating the modified marketing by placing the overlay marketing over the original marketing;

at the service provider, responsive to a determination that the local marketing content does not exist, sending a message to the DVR indicating that there is not any local marketing content; and

wherein, at the service provider, the location of the user is determined by cross-referencing the user ID with information stored in a user profile.

## **EVIDENCE APPENDIX**

This appeal brief presents no additional evidence.

## **RELATED PROCEEDINGS APPENDIX**

This appeal has no related proceedings.